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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER
TSUI, WILSON W

ART UNIT	PAPER NUMBER
2178	

DATE MAILED: 10/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>8/10/2006</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-24</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-24</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date <u>20060303</u>.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

1.   . This application is in response to the amendment filed on: 8/10/2006.

2.   Claims 1-24 are pending in the application. Claims 17, and 22 have been

amended.

3.   Acknowledgment has been made to the amendments to the Abstract, and the

objection to the abstract has been removed.

4.   The double patenting rejections for claims 1-24 are maintained, since no

Terminal Disclaimer has been received.

5.   The 35 USC 101 rejections for claims 17-24, are maintained (see response to

Argument's section below).

6.   Prior rejections (for claims 1-24) that fall under either 35 USC 102 or 35 USC 103

have been withdrawn, pursuant to applicant's argument concerning the effective filing

date of Kutay reference.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
conditions and requirements of this title.

7.   Claims 17-24 are rejected under 35 U.S.C. 101 because the claimed invention is

directed to non-statutory subject matter.

With regards to claim 17-24, for the claimed "computer program product" appears to be

directed to computer data structures not explicitly embodied in a computer readable

media, as it is stated in the claims to be "storing instructions for execution on a

(a) Functional Descriptive Material: "Data Structures" Representing Descriptive Material

Per Se or Computer Programs Representing Computer Listings *Per Se*

Data structures not claimed as embodied in computer-readable media are descriptive

material *per se* and are not statutory because they are not capable of causing functional

change in the computer. See, e.g., Warmerdam, 33 F.3d at 1361, 31 USPQ2d at

1760(claim to a data structure *per se* held nonstatutory). Such claimed data structures

do not define any structural and functional interrelationships between the data structure

and other claimed aspects of the invention, which permit the data structure's

functionality to be realized. In contrast, a claimed computer-readable medium encoded

with a data structure defines structural and functional interrelationships between the

data structure and the computer software and hardware components which permit the

data structure's functionality to be realized, and is thus statutory.

Double Patenting

8.   The nonstatutory double patenting rejection is based on a judicially created

doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the

unjustified or improper timewise extension of the "right to exclude" granted by a patent

and to prevent possible harassment by multiple assignees. A nonstatutory

obviousness-type double patenting rejection is appropriate where the conflicting claims

are not identical, but at least one examined application claim is not patentably distinct

from the reference claim(s) because the examined application claim is either anticipated

by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140

F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29

USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir.

1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422

F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163

USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d)

may be used to overcome an actual or provisional rejection based on a nonstatutory

double patenting ground provided the conflicting application or patent either is shown to

be commonly owned with this application, or claims an invention made as a result of

activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a

terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with

37 CFR 3.73(b).

9.   Claims 1-8 are rejected on the ground of nonstatutory obviousness-type double

patenting as being unpatentable over claims 1-6 of U.S. Patent No. 6,678,867 B2

(hereinafter '867). Although the conflicting claims are not identical, they are not

patentably distinct from each other for the following reasons.

Claim 1 of the '867 transforms/translates between a first structured format and

the second structured format, while claim 1 of the present invention translates between

an *element of the* first structured description/format *to at least one element of the*

second structural description.

However, it is inherent that a structured format will include at least one element,

and is also indicated by Appendix D of the '867.

Additionally, claim 1 of the '867 outputs from "the map editor, a map of the translation between the first structured format, and second structured format, based on the inputting from the second system, first system, and graphical user interface into the map editor (for which the inputting includes user references as also indicated in the claim: "inputting into a map editor from the graphical user interface user preferences ..." ('867, column 32, lines 7-9). Meanwhile, claim 1 of the present invention *stores* translation information comprising at least the preferences input by the user.

However, the ability to *store* output data is well known in the art. It would have been obvious for one of the ordinary skill in the art at the time of the invention to have modified the present invention such that the output translation information is stored, as well known in the art. The combination would have allowed the present invention to implement persistency of data for backup or later use.

Claims 2-5 of the present invention are adding the same limitations as claims 2-5 of '867. Therefore, claims 2-5 of the present invention are not patentably distinguishable over claims 2-5 of '867.

Claim 6 of the present invention includes a similar limitation (falls under the scope) as indicated in claim 1 of '867. Therefore, claim 6 of the present invention is not patentably distinguishable over claim 1 of '867.

Claim 7 and 8 of the present invention include the same limitations as claim 6 of '867, since the second structured format of XML as expressed by '867 also satisfies the second structured format derived from SGML, as known in the art.

10.   Claims 9-16 of the present invention, are similar to claims 1-8 of the present

invention, and are rejected on the ground of nonstatutory obviousness-type double

patenting as being unpatentable over claims 1-6 of U.S. Patent No. 6,678,867 B2

(hereinafter '867) under the same rationale.

11.   Claims 17-24 of the present invention, are similar to claims 1-8 of the present

invention, and are rejected on the ground of nonstatutory obviousness-type double

patenting as being unpatentable over claims 1-6 of U.S. Patent No. 6,678,867 B2

(hereinafter '867) under the same rationale.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12.   Claims 1-3, 5-7, 9-11, 13-15, 17-19, 21-23 are rejected under 35 U.S.C. 102(b)

as being anticipated by Rada et al ("Hypertext Interchange Using ICA", published: June

1995, pages 99-117).

With regards to claim 1. Rada et al teaches a method of transforming information,

comprising:

- *Inputting, into an editor, a first structural description of a first structured format.*

    (page 100: whereas, the original data representation/first-structural-description is

    specified)

- *Inputting, into the editor, a second structural description of a second structured format; inputting, into the editor by a user, preferences for transforming an element of the first structural description to at least one element of the second structural description* (pages 100 and 101: whereas, the intermediate format/second-structural description is also specified, and preferences for transforming an element of the first structural description to at least one element of the second structural description are also entered using the recoding and structural mapping toolset);

- *Storing translation information output from the editor, the translation information comprising at least the preferences input by the user* (page 101: whereas, the translation information is stored in a recoded file);

- *transforming first information provided in the first structured format into second information in the second structured format based on the translation information* (page 101: whereas, using the recoded file, the first structured format/specific/original data representation is converted to the second/general/intermediate structure representation using the Specific to General tool.

With regards to claim 2, which depends on claim 1, wherein *the first structured format has a Document Type Definition (DTD) directed hierarchy* (page 102: whereas, the first structured format, can be SGML (which includes a DTD), such that the second format will by a structural format for a hypertext system).

With regards to claim 3, which depends on claim 1, wherein *said first structured format*

is derived from Standard Generalized Markup Language (SGML), as similarly explained

in the rejection for claim 2, and is rejected under the same rationale.

With regards to claim 5, which depends on claim 3, *wherein the second structured*

format is a Document Type Definition (DTD) directed hierarchy (page 102: whereas, the

second structured format, can be the open and interchange layer, and the first

structured format can be the text markup language, such that the second structured

format is SGML (which includes a DTD)).

With regards to claim 6, which depends on claim 3, further comprising: *outputting, from*

the editor to a graphical user interface, a representation of a translation between the

first structured format and the second structured format (page 114: whereas, a

representation of a translation (translation from 'MUCH' to 'Guide') is shown/presented

on a computer screen).

With regards to claim 7, which depends on claim 3, wherein *the second structured*

format is derived from Standard Generalized Markup Language (SGML), as similarly

explained in the rejection for claim 5, and is rejected under the same rationale.

With regards to claim 9, for a system performing a method similar to the method of

claim 1, is rejected under the same rationale.

With regards to claim 10, which depends on claim 9, for a system performing a method

similar to the method of claim 2, is rejected under the same rationale.

With regards to claim 11, which depends on claim 9, for a system performing a method

similar to the method of claim 3, is rejected under the same rationale.

With regards to claim 13. which depends on claim 11, for a system performing a method

similar to the method of claim 5, is rejected under the same rationale.

With regards to claim 14. which depends on claim 11, for a system performing a method similar to the method of claim 6, is rejected under the same rationale.

With regards to claim 15, which depends on claim 11, for a system performing a method similar to the method of claim 7, is rejected under the same rationale.

With regards to claim 17, for a computer program product performing a method similar to the method of claim 1, is rejected under the same rationale.

With regards to claim 18, which depends on claim 17, for a computer program product performing a method similar to the method of claim 2, is rejected under the same rationale.

With regards to claim 19, which depends on claim 17, for a computer program product performing a method similar to the method of claim 3, is rejected under the same rationale.

With regards to claim 21, which depends on claim 19, for a computer program product performing a method similar to the method of claim 5, is rejected under the same rationale.

With regards to claim 22, which depends on claim 19, for a computer program product performing a method similar to the method of claim 6, is rejected under the same rationale.

With regards to claim 23, which depends on claim 19, for a computer program product performing a method similar to the method of claim 7, is rejected under the same rationale.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

13.   Claims 4, 8, 12, 16, 20, and 24 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Rada et al ("Hypertext Interchange Using ICA", published: June

1995, pages 99-117), in further view of Burnard ("SGML on the Web: too little too soon,

or too much too late?", published: November 1, pages 1-9).

With regards to claim 4, which depends on claim 3, RADA teaches *said first structured*

format, as similarly explained in the rejection for claim 1, and is rejected under the same

rationale. However, Rada does not expressly teach the first structured format is

eXstensible Markup Language (XML).

Burnard teaches a structured format is *eXstensible Markup Language (XML)*: whereas,

"XML is used as a leaner and simpler subset of the SGML metalanguage" (p8-1)

It would have been obvious to one of the ordinary skill in the art at the time of the

invention to have modified Rada's first structured format to have been the structured

format of XML, as taught by Burnard. The combination of Rada and Burnard would have

allowed Rada to have "been able to support a wide variety of applications, and with a

concise formal design" (Rada, p8-1).

With regards to claim 8, which depends on claim 7, RADA teaches *said second*

structured format, as similarly explained in the rejection for claim 1, and is rejected

under the same rationale. However, Rada does not expressly teach the second

structured format is *eXstensible Markup Language (XML)*.

Burnard teaches a structured format is *eXstensible Markup Language (XML)*: whereas,

"XML is used as a leaner and simpler subset of the SGML metalanguage" (p8-1)

It would have been obvious to one of the ordinary skill in the art at the time of the

invention to have modified Rada's second structured format to have been the structured

format of XML, as taught by Burnard. The combination of Rada and Burnard would have

allowed Rada to have "been able to support a wide variety of applications, and with a

concise formal design" (Rada, p8-1).

With regards to claim 12, which depends on claim 11, for a system performing a method

similar to the method of claim 4, is rejected under the same rationale.

With regards to claim 16, which depends on claim 15, for a system performing a method

similar to the method of claim 8, is rejected under the same rationale

With regards to claim 20, which depends on claim 19, for a computer program product

performing a method similar to the method of claim 4, is rejected under the same

rationale.

With regards to claim 24, which depends on claim 23, for a computer program product

performing a method similar to the method of claim 8, is rejected under the same

rationale.

Response to Arguments

14.   Applicant's arguments with respect to claims 1-24 have been considered but are

moot in view of the new ground(s) of rejection.

15.   Applicant submits/argues that the amended claims overcome the 101 rejection

from the previous office action. However, the Office respectfully points out that although

the amended claims 17-24 include the computer program product as being stored and

executed, the claims still do not expressly indicate, or necessarily imply that the

computer program product is stored *on a computer readable medium.* As a suggestion,

the Office recommends including the language of having the computer program product

to be *stored "on a computer readable medium",* to overcome the 101 rejection.

Conclusion

16.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Wilson Tsui whose telephone number is (571)272-7596.

The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Stephen Hong can be reached on (571) 272-4124. The fax phone number

for the organization where this application or proceeding is assigned is 571-273-8300.

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USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Wilson Tsui
Patent Examiner
Art Unit: 2178
October 12, 2006

STEPHEN HONG
SUPERVISORY PATENT EXAMINER